

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant (s): Kobayashi et al.

Serial No.: 10/587,088

Group Art Unit: 1625

Filing Date: 21 July 2006

Examiner: Mabry

For: METHOD FOR PRODUCING OPTICALLY ACTIVE HYDROXYMETHYLATED COMPOUNDS

RESPONSE TO RESTRICTION REQUIREMENT

This paper is being filed in response to the restriction requirement that was mailed in this case on 27 February 2009. A petition for a two-month extension of time and required fee accompany this paper.

In response to the restriction requirement, applicants provisionally elect, subject to traverse, the group III claims, wherein in chemical formula 1, R<sup>3</sup> and R<sup>4</sup> are both hydrogen, R<sup>1</sup> and R<sup>2</sup> are each t-butyl and X<sup>1</sup> and X<sup>2</sup> are each hydroxyl. The resulting species is described in Production Example 1, page 6 of the specification.

The restriction requirement is based on the allegation that the technical linking feature of the claims is found in structures 7a, 7b, 8a and 8b reported the JACS 2002 article (Denmark et al) cited in the action. However, the 7a, 7b, 8a and 8b structures in the JACS article describe N-oxide compounds, not the pyridinyl compounds that correspond to chemical formula 1 of applicant's claims. This is clearly shown even in the structure reproduced in the office action. Therefore, the JACS 2002 article does not describe the technical linking feature of the claims of this application.

Furthermore, claim 3 is drawn to a catalyst that is prepared from the chemical formula 1 material, and a Lewis acid represented by MY<sub>n</sub>. It is this catalyst, not simply the chemical formula 1 compound, which is the technical linking feature common to all claims.

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The JACS 2002 article does not describe catalysts made using the MY<sub>n</sub> material, and fails to describe the technical linking feature of the claims for that additional reason.

Respectfully submitted,  
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